

## REMARKS

Claims 1-16 are pending in this application. Claims 1 and 9, the independent claims, have been amended to define still more clearly what Applicant regards as his invention; no change in scope of these claims is either intended or believed to be effected by the changes.

Claims 1-8 were rejected under 35 U.S.C. § 101 as set out at paragraphs 3 and 4 of the Office Action. The Examiner states that the claimed invention appears to cover two statutory classes, since claim 1 recites “In a method of a fire extinguishing spray apparatus...” which, the Examiner concludes, is directed to a process and an apparatus. Applicant has amended the preamble of claim 1 to recite “In a method for use in conjunction with a fire extinguishing spraying apparatus...” It is submitted, therefore, that claim 1 is directed to a process. Accordingly, withdrawal of the rejection under Section 101 is respectfully requested.

Claims 1-8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. At paragraph 5 of the Office Action, the Examiner states that claim 1 recites “In a method of a fire extinguishing spray apparatus...” which, the Examiner concludes, makes it unclear as to whether claim 1 is directed to a process or an apparatus. As noted above, Applicant has amended the preamble of claim 1 to recite “In a method for use in conjunction with a fire extinguishing spraying apparatus...” It is submitted, therefore, that claim 1 is directed to a process. Accordingly, it is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1-6, 9, 11-13, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,941,505 to Kirkelund; and claims 1-6, 9, 11-13, and 15, as being anticipated by U.S. Patent No. 5,398,765 to Worthington. Claims 8, 10, 14, and 15 were rejected under 35 U.S.C. 103(a) as being obvious from Kirkelund; claim 7, as being obvious from Kirkelund in view of U.S. Patent No. 6,520,767 to Ahern; and claims 7, 8, 10, 14, and 16, as being obvious from Worthington.

Applicant submits that independent claims 1 and 9, together with the claims dependent therefrom, are patentably distinct from the cited references for at least the following reasons.

Claim 9 is directed to a fire extinguishing spraying apparatus comprising a source of an extinguishing medium, pump means, and means for conducting at least some of the extinguishing medium to at least one nozzle. The improvements comprise (1) means for re-circulating at least some of the extinguishing medium from a pressure side of the pump means to a suction side of the pump means, and (2) means for passing at least some of the extinguishing medium being re-circulated into a discharge pipe and any remaining extinguishing medium being re-circulated into the pump means.

Kirkelund, as understood by Applicant, relates to an oil supply system for a burner nozzle including means for preventing the nozzle from dripping.

Immediately, Applicant notes that Kirkelund cannot anticipate claim 9, since it is not a fire extinguishing spray apparatus at all, does not extinguish fires, and cannot extinguish fires. Kirkelund, as noted, is a system that supplies oil to a burner nozzle, and, particularly, aims to prevent oil from dripping from the burner nozzle. A burner nozzle that is supplied with oil is *exactly the opposite* of a fire extinguishing spray apparatus.

Despite this, the Examiner states, at page 5 of the Office Action:

The recitation “In a fire extinguishing spraying apparatus” in the preamble is merely a name of the spraying apparatus. The name “fire extinguishing spraying apparatus” does not breathe life and meaning to the claim. The body of the claim fails to define any fire extinguishing limitations. Applicant’s device too is not a fire extinguishing spraying apparatus until it actually extinguishes fire. Until then, it is merely a name which indicates intended use.

Applicant, in previous papers, has explained repeatedly to the Examiner why the preamble of Jepson claim 9 is not merely a name of the spraying apparatus. For example Applicant has cited MPEP 211.02(II), which provides:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966.

The "entirety of the record" reveals that Applicant invented and intended to cover in claim 9 a fire extinguishing spraying apparatus as set forth in the preamble. Applicant, in the Response filed on February 4, 2008, pointed out page and line numbers of the specification which refer especially to a fire extinguishing apparatus. A burner nozzle that is supplied with oil, as in Kirkelund, simply cannot anticipate the fire extinguishing spraying apparatus of claim 9.

Nevertheless, in an effort to advance prosecution, Applicant has now clarified the body of claim 9 to recite that the fire extinguishing spray apparatus includes means for recirculating and passing at least some of an extinguishing medium. The oil supplied to the burner nozzle, as in Kirkelund, cannot be an extinguishing medium.

The Examiner continues at page 5 of the Office Action, stating: "In Kirkelund's device, the intended use can be a 'fire extinguishing spraying apparatus' by preventing oil drip and cutting off the supply of fuel." Applicant is unable to comprehend how a system that can prevent oil drip from its burner nozzle could be used to extinguish a fire that exists elsewhere, which is what fire extinguishers are used for. Further, claim 9 is directed to a fire extinguishing *spraying* apparatus in which *extinguishing* medium is conducted to a nozzle and can extinguish a fire when sprayed; the burner nozzle of Kirkelund, which contains *oil*, cannot extinguish a fire by *spraying* it. Again, an oil supply system for a burner nozzle is *exactly the opposite* of the fire extinguishing spraying apparatus of claim 9. Turning *off* the burner nozzle of Kirkelund would not help extinguish a fire that exists elsewhere, and turning *on* the burner nozzle of Kirkelund would only exacerbate any fire by spewing oil from its

nozzle.

The Examiner continues, again at page 5 of the Office Action: “The burner of Kirkelund can be used to power a fire extinguishing device, e.g., the burner used to power a steam engine that powers a water pump.” However, Applicant has not claimed a system that *powers* a fire extinguishing apparatus; claim 9 is directed to a fire extinguishing spray apparatus.

Nothing in Kirkelund would teach or suggest a *fire extinguishing spray apparatus* including means for re-circulating an *extinguishing* medium and means for passing at least some of the *extinguishing* medium, as recited in claim 9.

Moreover, the Examiner also states, at page 5 of the Office Action, that Kirkelund discloses “means (branch in line 41 leading to supply 16) for passing at least some of the medium being re-circulated into a discharge pipe 41 (discharge pipe 41 leading to supply 16).” First, Kirkelund does not circulate an extinguishing medium, as recited in claim 9. Second, even putting aside that Kirkelund does not circulate an extinguishing medium, 16 of Kirkelund is an oil supply and is not a *discharge pipe*. The oil supply system of Fig. 1 of Kirkelund takes oil from oil supply 16 and supplies it to the pump 12. Thus, the oil supply 16 *does not discharge oil, but, instead, supplies it to the pump 12*. The Examiner even admits this, when he writes “leading back to supply 16.”

Element 16 of Kirkelund is similar to a break tank, which is what the present invention intends to avoid (see, e.g., page 1, lines 18-35 of the present application). Specifically, the oil supply 16 of Kirkelund is also a break tank where the returned oil stays long enough in order to be cooled down before being circulated by the pump.

For at least the foregoing reasons, claim 9 is seen to be clearly allowable over Kirkelund.

Independent claim 1 recites features which are similar in many relevant respects to

those discussed above in connection with claim 9. Accordingly, Claim 1 is believed to be patentable over Kirkelund for at least the same reasons as discussed above.

Worthington, as understood by Applicant, relates to a mobile modular foam fire suppression apparatus. Fig. 1 is an isometric view of a firefighting scene showing a method of fighting a fire.

The Examiner, at page 7 of the Office Action, asserts that Worthington discloses “passing at least some of the medium re-circulated into a discharge pipe 28.” At column 3, lines 26-30 of Worthington, it is stated that:

Excess foam concentrate that is not immediately used is discharged through a foam concentrate return hose 28, which is connected to a foam concentrate return line port 30 and an intake 32 on the foam concentrate supply vessel 16.

The vessel 16 (see Fig. 1) is in fact a break tank; the excess of foam concentrate is returned to vessel 16 and then back to the suction side of the pump via a foam concentrate intake line 22. Nothing in Worthington would teach or suggest passing at least some of the extinguishing medium being re-circulated *into a discharge pipe*, as recited in claim 9.

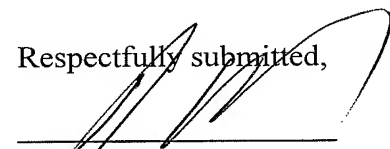
For at least the foregoing reasons, claim 9 is seen to be clearly allowable over Worthington.

Independent claim 1 recites features which are similar in many relevant respects to those discussed above in connection with claim 9. Accordingly, Claim 1 is believed to be patentable over Worthington for at least the same reasons as discussed above.

The other claims in this application are each dependent from one or the other of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Respectfully submitted,



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